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PATENT
Docket No. P1230

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

APPELLANT: NOEL LEE

SERIAL NO.: 09/735,697

EXAMINER: DEBERADINIS, ROBERT

FILED: DECEMBER 12, 2000

ART UNIT: 2836

FOR: APPARATUS AND METHOD FOR POWERING MULTIPLE
PERIPHERAL DEVICES FROM A COLOR-CODED CENTRAL
POWER SOURCE

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APPLICANT'S PETITION TO REOPEN PROSECUTION

Pursuant to 37 CFR 41.35(b), Applicant submits this Petition To Reopen Prosecution on the grounds that the file is not complete in light of the United States Supreme Court's recent unanimous decision in *KSR International Co. v. Teleflex, Inc. et al.*, 550 U.S. ____, 82 USPQ2d 1385 (2007) (decided April 30, 2007), and in further light of the Memorandum to all Technology Center Directors from Deputy Commissioner for Patent Operations, Ms. Margaret A. Focarino,

regarding interim guidelines for examination of obviousness determinations. See attached.

The *KSR* decision alters the obviousness analysis with regard to the “teaching, suggestion or motivation” (TSM) factors. As set out in Deputy Commissioner Focarino’s memo, the Supreme Court eliminated the need for Examiner’s to identify a specific “teaching, suggestion or motivation” in the prior art in order to combine prior art references in making a rejection. Instead, she indicated that the Court reaffirmed the factors enumerated in *Graham v. John Deere*, 383 U.S. 1 (1966), and stated that it is necessary to determine whether there was an **apparent reason** to combine known elements in the fashion claimed, and that the analysis **should be made explicit**. (Emphasis in original). Moreover, she instructed the Examiners to “identify a reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.” The *KSR* opinion also raises additional issues not set forth in the Deputy Commissioner’s memo, such as the examiner’s status as a “person having ordinary skill in the art”, the use of “common sense” in making a determination to combine references, the examiner’s ability to rely on his personal knowledge without documentary support, the importance of secondary considerations and hindsight distortion.

As set out in the briefs by the Applicant and Examiner, the present matter involves an appeal of the rejection of the claimed invention on the grounds that it would have been obvious to combine the teachings of prior art references, and such combination would render the claimed invention unpatentable. Extensive briefing has been rendered regarding the teaching, suggestion, or motivation factors to combine these references.

However, due to the *KSR* opinion being released after the conclusion of the briefing in this matter, neither the Applicant nor the Examiner has had an opportunity to address the issues raised therein. Accordingly, the record is void of arguments directed toward the analysis set forth in *KSR*, i.e., an explicit analysis on the apparent reasons to combine the prior art references. Considering the *KSR* decision will, in all likelihood, be incorporated into the Board's deliberations on this matter, the need for such analysis in the record is critical. Without such, the Board would be rendering a determination on an incomplete record.

Accordingly, Applicant respectfully requests that this matter be remanded back to the Examiner in order for prosecution to be reopened so that the rejection of the claimed invention can be considered in light of the *KSR* opinion. This action would allow for this matter to either be resolved during prosecution or in the event of an appeal, for there to be a complete record before the Board.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Brent A. Capehart", written in a cursive style.

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MEMORANDUM

DATE: May 3, 2007

TO: Technology Center Directors

FROM: Margaret A. Focarino
Margaret A. Focarino
Deputy Commissioner
for Patent Operations

SUBJECT: Supreme Court decision on *KSR Int'l. Co., v. Teleflex, Inc.*

The Supreme Court has issued its opinion in *KSR*, regarding the issue of obviousness under 35 U.S.C. § 103(a) when the claim recites a combination of elements of the prior art. *KSR Int'l Co. v. Teleflex, Inc.*, No 04-1350 (U.S. Apr. 30, 2007). A copy of the decision is available at <http://www.supremecourt.us.gov/opinions/06pdf/04-1350.pdf>. The Office is studying the opinion and will issue guidance to the patent examining corps in view of the *KSR* decision in the near future. Until the guidance is issued, the following points should be noted:

- (1) The Court reaffirmed the *Graham* factors in the determination of obviousness under 35 U.S.C. § 103(a). The four factual inquiries under *Graham* are:
- (a) determining the scope and contents of the prior art;
 - (b) ascertaining the differences between the prior art and the claims in issue;
 - (c) resolving the level of ordinary skill in the pertinent art; and
 - (d) evaluating evidence of secondary consideration.

Graham v. John Deere, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

- (2) The Court did not totally reject the use of "teaching, suggestion, or motivation" as a factor in the obviousness analysis. Rather, the Court recognized that a showing of "teaching, suggestion, or motivation" to combine the prior art to meet the claimed subject matter could provide a helpful insight in determining whether the claimed subject matter is obvious under 35 U.S.C. § 103(a).

- (3) The Court rejected a rigid application of the "teaching, suggestion, or motivation" (TSM) test, which required a showing of some teaching, suggestion, or motivation in the prior art that would lead one of ordinary skill in the art to combine the prior art elements in the manner claimed in the application or patent before holding the claimed subject matter to be obvious.

(4) The Court noted that the analysis supporting a rejection under 35 U.S.C. § 103(a) should be made explicit, and that it was "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. The Court specifically stated:

Often, it will be necessary . . . to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an **apparent reason** to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis **should be made explicit**.

KSR, slip op. at 14 (emphasis added).

Therefore, in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.